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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,293	03/01/2005	Daniel Baumgartner	001227/0205	6294
69095 7590 02/12/2009 STROOCK & STROOCK & LAVAN, LLP 180 MAIDEN LANE NEW YORK, NY 10038				
EXAMINER				
PRONE, CHRISTOPHER D				
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3738				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/526,293

**Applicant(s)**

BAUMGARTNER ET AL.

**Examiner**

CHRISTOPHER D. PRONE

**Art Unit**

3738

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-8 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8 and 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because it contains more than 150 words. The applicant failed to address this deficiency in the previous amendment. The applicant is requested to argue against the objection or amend the abstract to correlate with the requirements of MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

Claim 5 is objected to because of the following informalities: broad unclear language. Claim 5 defines structure as being "different". However the applicant fails to define how are they different? Different could be interpreted broadly to mean distinct separate allowing the presence of two radii or varying sizes. Applicant is advised to change the language to read that they are unequal or something to that order. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4 and 5 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 4 and 5 recite the language in the last line: "contact one another via line contact", which is unclear and unsupported by the application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 1 the applicant requires the upper terminal part to have a concave inner surface 7 in line 15. This surface is not concave because it only curves in one direction. A line can be concave in this manner but for a surface to be concave it must be curved in more than one direction like a contact lens.

In regards to claims 4 and 5, the language of the last line reciting: "contact one another via line contact" is unclear and indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-7, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Buettner-Janz et al USPN 4,759,766.

Buettner discloses the same invention being an intervertebral implant shown best in figure 11. The implant comprises upper terminal part 11a comprising a concave inner surface, lower terminal part 11b comprising a concave inner surface, and a joint element 12a that has a sliding engagement with the concave surfaces. The surfaces are smooth and rotationally symmetrical about axes that cross, but are separate from each other. In regards to the acute angle between the second joint and the central axis it is clear from looking at figures 11 and 10A that the surfaces of the joint are identical to those shown in figure 1 of the current application. Furthermore in view of the applicant's failure to include a range limitation it is therefore inherent that the angle is acute.

In regards to claim 13 Buettner further discloses the use of anchoring texture 3 on the exterior surface for better attachment to the implant site.

In regards to claim 15 Buettner further discloses stops extending down from the front and back of the upper terminal element that extend parallel to the central axis.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buettner-Janz et al USPN 4,759,766.

Buettner discloses the invention substantially as claimed being described supra. However, Buettner does not disclose the specific angles of rotation and dimensions in millimeters of the implant. It would have been obvious to one having ordinary skill in the art at the time that the implant of Buettner would rotate along the second axis that is at an angle between 60 and 88 degrees in order to mimic the natural movement of the spine. It also would have been obvious to one having ordinary skill in the art at the time that the implant of Buettner would have a thickness that would offset the rotational axis between 0 and 18 millimeters to mimic the natural movement of the spine.

Claim 14 is rejected under 35 U.S.C. 103 as being unpatentable over Buettner-Janz et al USPN 4,759,766 in view of Navarro et al 5,534,030.

Buettner discloses the invention substantially as claimed being described supra. However, Buettner does not disclose that the external surface of the implant comprises a titanium grid.

Navarro teaches the use of a spinal implant comprising a titanium grid coating 66-74 in the same field of endeavor for the purpose of enhancing ingrowth.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the titanium coating taught by Navarro with the implant of Buettner in order to enhance the bone ingrowth capabilities of the device.

Claim 17 is rejected under 35 U.S.C. 103 as being unpatentable over Buettner-Janz et al USPN 4,759,766 in view of Jones et al 5,879,387.

Buettner discloses the invention substantially as claimed being described supra. However, Buettner does not disclose that the terminal elements comprise three parts.

Jones teaches the use of a and a method for making a terminal component of an implant comprising a cover plate 7, a joint pan 4, and an elastic spacer 5 in the same field of endeavor for the purpose of reducing wear during normal use.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the multiple layers taught by Jones with the implant of Buettner in order to reducing wear during normal use of the device.

### ***Response to Arguments***

Applicant's arguments filed 11/19/08 have been fully considered but they are not persuasive. The applicant argues that the independent claims is not properly rejected because Buettner-Janz fails to disclose the required axis of rotations angle  $\alpha$  and spaced apart by distance A, but the independent fails to provide any range for these variable. The applicant is **STRONGLY** advised to incorporate the angle range described in the specification into the independent claims along with **FACTUAL** based arguments why this range is not an obvious modification to overcome the art of record.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571)272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone  
Examiner  
Art Unit 3738

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/Corrine M McDermott/

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Supervisory Patent Examiner, Art Unit 3738